

Remarks

Claims 13, 86-88 stand rejected under 35 U.S.C. §102(b) as being anticipated by U. S. Patent No. 6,026,397 to Sheppard ("Sheppard"). Claims 14, 17-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sheppard in view of U. S. Patent No. 5,764,774 to Liu ("Liu"). Claims 15-16, 47-54 and 69-72 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sheppard in view of U. S. Patent No. 6,902,114 to Hashimoto et al. ("Hashimoto"). Claims 73-85 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sheppard in view of U. S. Patent No. 5,837,986 to Barile et al. ("Barile").

According to MPEP §2131, "to anticipate a claim, the reference must teach every element of the claim." A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

According to the MPEP §2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A telephone interview between Examiner Le and applicants' representative George Blasiak was held on September 26, 2006. A Communication to Record Substance of Interview respecting that interview is filed concurrently and incorporated herein by reference.

The Examiner has conceded that the relied upon section of Sheppard does not contain teachings relating to an encoder of any of the types recited in applicants' claims and, accordingly, has further conceded that the rejections of claims 13-18, 47-54, and 69-88 over Sheppard or over Sheppard in combination with another reference were improperly made. Accordingly, applicants respectfully request withdrawal of the rejections over Sheppard alone or in combination and passage to allowance of the above identified application.

Regarding the claims discussed herein, the applicants' selective treatment and emphasis of independent claims of the application should not be taken an indication that the applicants believe that the Examiner's dependent claim rejections are otherwise sufficient. In fact, it is noted in the office action that the dependent claims are rejected without substantial, and in certain instances, without any reference to the limitations of the dependent claims in combination with the base claim elements. In rejecting claims for want of novelty or for obviousness, the Examiner must cite the best references at his/her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. *37 C.F.R. 1.104(c)(2)*. If the Examiner will maintain the rejections of the claims including the dependent claims, the Examiner is respectfully requested to specify which claims are being rejected when references are discussed. The Examiner is further respectfully requested to specify each claim, including each dependent claim in making the rejections in accordance with the requirements of *37 C.F.R. §1.104*.

While the applicants herein may have highlighted a particular claim element of a claim for purposes of demonstrating an insufficiency of an examination on the part of an Examiner, the applicants highlighting of a particular claim element for such limited purpose should not be taken to indicate that the applicants have taken the position that a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present.


No amendment presented herein contains new matter. Applicants have amended the claims in minor respects to address minor informalities. In that the amendments do not alter the scope of the claims, they will not be regarded as "narrowing" claim amendments.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

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Respectfully submitted,

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